

REMARKS

I. Introduction

Claims 1 to 20 are currently pending in this application. Claims 11 to 18 have been withdrawn from consideration. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 1 to 10, 19 and 20 Under 35 U.S.C. § 102 (b)

Claims 1 to 10, 19 and 20 were rejected under 35 U.S.C. § 102 (b) as anticipated by U.S. Patent No. 5,386,973 ("Brenner et al."). Applicant respectfully submits that Brenner et al. do not anticipate claims 1 to 10, 19 and 20 for the following reasons.

Claim 1 relates to a hydraulic bearing. Claim 1 recites that the hydraulic bearing includes a journal bearing and a supporting bearing which are joined by a spring body made of a rubber elastic material and border on at least one working space and at least one compensating space. Claim 1 further recites that the working space and the compensating space are each filled with a damping fluid and communicate through a damping device in a fluid-conducting manner, wherein, in response to relative radial displacement of the journal bearing and the supporting bearing with respect to one another, the damping device has damping fluid flowing through it.

Brenner et al. purportedly relate to an elastomeric bearing. Abstract. Brenner et al. state that the bearing includes at least two fastening parts 7 and 8 connected to one another by means of an elastomer spring 6. Inside the elastomeric bearing at least two damping devices are stated to work essentially independent of one another. See col. 4, lines 4 to 12. The first independent damping device is stated to include chambers 3a and 3b, which are stated to communicate via passage 4. The second independent damping device is stated to include chambers 1a and 1b, which are stated to be separated by partition 10 having passage 2. The first independent damping device is stated to dampen in the radial direction and the second independent damping device is stated to dampen in the longitudinal direction. See col. 4, lines 17 to 40. Accordingly, fluid only flows through partition 10 (damping device) in the second damping device when parts 7 or

8 are excited in a longitudinal direction. Opening 15 is stated to be provided for pressure equalization between chambers 3a, 3b and chambers 1a, 1b. See col. 10, lines 22 to 26. However, Brenner et al. do not disclose, or even suggest, that in response to relative radial displacement of the journal bearing and the supporting bearing with respect to one another, the damping device has damping fluid flowing through it, as recited in claim 1. Therefore, Brenner et al. do not disclose all of the limitations of claim 1.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Brenner et al. do not disclose, or even suggest, a working space and a compensating space that are each filled with a damping fluid and communicate through a damping device in a fluid-conducting manner, wherein, in response to relative radial displacement of the journal bearing and the supporting bearing with respect to one another, the damping device has damping fluid flowing through it, as recited in claim 1. Therefore, it is respectfully submitted that Brenner et al. do not anticipate claim 1.

Additionally, to reject a claim under 35 U.S.C. § 102, the Examiner must demonstrate that each and every claim limitation is contained in a single prior art reference. See, *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Still further, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See, *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In particular, it is respectfully submitted that, at least for the reasons discussed above, the reference relied upon would not enable a person having ordinary skill in the art to practice the inventions of the rejected claims, as discussed above.

The Final Office Action alleges that because "opening 15 allows fluid communication between the chambers, radial vibrations must necessarily cause fluid flow, even if such flow is minimal, through the damping device 2 according to the claimed combination." See Final Office Action at p. 3. The Final Office Action in effect admits that Brenner et al. does not directly disclose the limitation of claim 1, i.e., that in response to relative radial displacement of the journal bearing and the supporting bearing with respect to one another the damping device has damping fluid flowing through it, but rather seems to be arguing the inherency of this limitation, i.e., that given the existence of opening 15 radial vibrations must necessarily cause fluid flow between the chambers. See Final Office Action at p. 3.

To the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art." See M.P.E.P. § 2112; emphasis in original; and see, *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Nowhere does the Examiner rely on technical reasoning to support its conclusion that fluid necessarily flows between passages 1a and 4 in response to a relative radial displacement of the first and second independent damping devices. Brenner et al. merely state that opening 15 is provided for pressure equalization between chambers 3a, 3b and chambers 1a, 1b. See col. 10, lines 22 to 26. Given the very small size of opening 15 it seems that opening 15 may, if at all, equalize longer term pressure differentials. Accordingly, it is possible that in response to a rapid radial displacement of the first and second independent damping devices no fluid at all flows through opening 15. Further, it is also possible that a relative radial displacement of the first and second independent damping devices, in certain circumstances given for example, the interconnection of passages 1a and 1b, may not cause a pressure differential between passages 1a and 4 and, thus, may not result in damping fluid flow, as recited in claim 1. Note again that Brenner et al. only disclose pressure equalization through opening 15 not, specifically, fluid flow in response to a relative radial displacement of the first and second damping devices. See col. 10, lines 22 to 26. Accordingly, the anticipation rejection as to the rejected claims must necessarily fail for the foregoing reasons.

Therefore, withdrawal of the 35 U.S.C. § 102(b) rejection and allowance of claim 1 is respectfully requested.

As for claims 2 to 10, 19 and 20 which ultimately depend on claim 1 and therefore include all of the limitations of claim 1, Applicant respectfully submits that these claims are patentable for at least the same reasons provided above in support of the patentability of claim 1. Therefore, withdrawal of the 35 U.S.C. § 102(b) rejection and allowance of claims 2 to 10, 19 and 20 is respectfully requested.

III. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

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By: 

Richard M. Rosati
Reg. No. 31,792

One Broadway
New York, New York 10004
(212) 425-7200